REMARKS

Amendment to the Specification

The specification has been amended to add the priority information necessary to comply with 35 U.S.C. § 119(e) and 37 C.F.R. § 1.78. Applicants previously made a proper claim to priority under Article 8 of the Patent Cooperation Treaty (See pages 1-2 of the Declaration and Power of Attorney filed March 20, 2001).

Comments Regarding Restriction Requirement

Applicants hereby elect, with traverse, to prosecute Group I, which corresponds to claims 1-6, 8, 10-11, and 15 drawn to polynucleotides, polypeptides, vectors, host cells, and methods of making the polypeptides.

The rules under M.P.E.P. § 1893.03(d) require the Examiner to apply the Unity of Invention standard set forth in PCT Rule 13.2 instead of U.S. restriction/election of species practice in national stage applications, such as the instant application filed under 35 U.S.C. 371:

> Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage (filed under 35 U.S.C. 371) applications.

Applicants, therefore, request that the Examiner withdraw the Restriction Requirement at least with respect to claim 9 (Group III), drawn to an antibody. Applicants believe claim 9 meets the unity of invention standards because of its dependence on an independent claim of Group I and should be examined together with the elected polypeptide claims of Group I.

Unity of invention exists with respect to dependent claims in the same claim category as the independent claim from which they depend.

MPEP section 1850(A) and 1893.03(d), which recite the provisions of paragraph (c) of Part 1 (entitled "Instructions Concerning Unity of Invention") of Annex B (entitled "Unity of Invention") to the Administrative Instructions Under the PCT, provides:

> **(A) Independent and Dependent Claims.**
>
> Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression "category of claim"

> referring to the classification of claims according to the subject matter of the invention claimed for example, product, process, use or apparatus or means, etc.).
>
> (i) If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, **it does not matter if a dependent claim itself contains a further invention**.... (Emphasis added.)

See MPEP section 1850(A) at page 1800-61. See also MPEP Appendix AI at page 53. The antibodies to which claim 9 is drawn are limited by "all the features of another claim," in that the claimed antibodies specifically bind to a polypeptide of claim 1. Accordingly, because claim 9 is a dependent claim that is in the same category as and contains all the features of claim 1, it should be examined together with claim 1, which is drawn to the polypeptides, from which claim 9 depends.

Minimal burden to search new claims 24-26

Applicants also respectfully submit that there is minimal additional burden on the Examiner to examine claims 12-14 (Group IV), which are drawn to methods of using the elected polynucleotides, claims 16 (Group V), 20 (Group IX), and new claim 24, which are drawn to methods of using the elected polypeptides, and new claims 25 and 26, which are drawn to microarrays using the elected polynucleotides. The search required to identify prior art relevant to these claims should substantially overlap with that required for examination of the elected polynucleotides and polypeptides of Group I.

Rejoinder of method claims upon allowance of product claims under U.S. practice

The Examiner is reminded that claims 12-14 (Group IV), which are drawn to methods of using the elected polynucleotides, and claims 16 (Group V), 20 (Group IX), and new claim 24, which are drawn to methods of using the elected polypeptides, should be rejoined per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of product claims, for rejoinder of process claims covering the same scope of products. Applicants request that claims 12-14, 16, 20, and 24 be rejoined and examined upon allowance of the claims drawn to the elected polynucleotides and polypeptides of Group I.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,

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